



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/295,856 04/21/99 COLLART

T IACTP005

TM02/1109

ATTEN: THOMAS F. LEBENS
FITCH, EVEN, TABIN& FLANNERY
120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO IL 60603-4277

EXAMINER

RODRIGUEZ, P

ART UNIT

PAPER NUMBER

2121

DATE MAILED:

11/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/295,856

Applicant(s)

COLLART, TODD R.

Examiner

Paul L Rodriguez

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed 9/17/01 has been received and considered.
2. Examiner would like to address the claim numbering. As a reminder, claims 19 and 20 were added to the case in the amendment filed 10/13/00 and were later cancelled by the amendment filed 3/15/01. The current amendment filed 9/17/01 added new claims 19-34 however these claims have been renumbered as per rule 1.126 as claims 21-36.
3. Claims 21-36 are presented for examination.

Specification

4. The abstract of the disclosure is objected to because the abstract states that the electronic storage medium is tracked while being shipped between various entities using the tracking identifier on the package, however the claims are directed toward the tracking identifier when the electronic storage medium is accessed by a computer, i.e. located at the final destination and not during the shipping between various entities. Correction is required. See MPEP § 608.01(b).

Claim Objections

5. Claims 26, 27 and 34 are objected to because of the following informalities:

Claim 26 and 27 use the acronym URL in the claim language, which is not defined and may render the claim indefinite.

Claim 34 refers to "the retailer" however "a retailer" was not previously mentioned in the claim language and could create an antecedent problem in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 21-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 21, 26, 28 and 30 recites the limitation "the electronic storage medium" in claim 21 lines 4-5, claim 26 lines 4-5, claim 28 lines 4-5 and claim 30 lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claims 21, 26, 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Mages et al (U.S. Pat 5,892,825). The claimed invention reads on Mages et al as follows:

Mages et al discloses a method for tracking the distribution of content electronically (col. 4 lines 24-31), comprising the steps of detecting a tracking identifier when the electronic storage medium is accessed by a computer (abstract, col. 4 lines 20-23), transmitting, as a function of the

Art Unit: 2121

tracking identifier having been detected, tracking information to a server computer (col. 4 lines 47-57, block 60, col. 5 lines 64-66), determining, as a function of the tracking information having been transmitted to the server computer, an appropriate advertisement to transmit to the computer utilizing logic in the server computer (col. 4 lines 7-17, 24-31), determining, as a function of the tracking information having been transmitted to the server computer, an appropriate URL to transmit to the computer utilizing logic in the server computer (col. 4 lines 7-42, col. 4 lines 28-31 specifically, the examiner considers the "address" of stores or advertisers to include Internet addresses which would be a Uniform Resource Locator), determining, as a function of the tracking information having been transmitted, an appropriate updated software version to transmit to the computer utilizing logic in the server computer (col. 4 lines 7-17, examiner considers "updated" and "specific tracks on the CD-ROM can thereby be controlled by the remote server" as meeting this limitation), wherein updated software version is an application that plays the content on the electronic storage medium (col. 4 lines 58-64), and determining, as a function of the tracking information having been transmitted to the server computer, an appropriate channel to transmit to the computer utilizing logic in the server computer (col. 7 lines 21-26, examiner considers the "socket-to-socket" connection established by the server as the "channel").

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 22-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al (U.S. Pat 5,892,825) in view of Brindze et al (U.S. Pat 5,822,291).

Mages et al teaches most all of the instant invention as applied to claims 21, 26, 28-30 and also teaches determining appropriate advertisement to transmit to the computer utilizing logic in the server computer (col. 4 lines 7-31), determining authorization for sending information to the computer (step 74), and the URL of the content provider (col. 4 lines 7-42).

Mages et al fails to teach further comprising determining as a function of the tracking information a retailer that sold the electronic storage medium, performing a table lookup to determine one or more authorized titles, further comprising writing a transaction to a database memorializing processing and the URL includes an address of a website of a retailer where the electronic storage medium was purchased.

Brindze et al teaches further comprising determining as a function of the tracking information a retailer that sold the electronic storage medium (col. 11 line 53 – col. 12 line 33), performing a table lookup to determine one or more authorized titles (col. 9 lines 25-49), further comprising writing a transaction to a database memorializing processing (col. 5 lines 1-7, col. 9 line 35 – col. 10 line 20, col. 12 lines 1-18) and the URL includes an address of a website of a retailer where the electronic storage medium was purchased (col. 11 line 53 – col. 12 line 33).

Mages et al and Brindze et al are analogous art because they both provide tracking for individual electronic storage medium.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize retailer tracking, determining authorized titles and memorializing transactions of Brindze et al in the CD-ROM tracking and keying system of Mages et al because Brindze et al teaches controlling the authorization and use of electronic

media to stop piracy of content, improved marketing by retailers and tracking of individual copies of mass produced works (col. 1 line 10-50).

13. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al (U.S. Pat 5,892,825) in view of Takahashi (U.S. Pat 5,878,020).

Mages et al fails to teach the electronic storage medium tracking identifier is in a burst cut area and a digital code is in the burst cut area.

Takahashi teaches an optical disc electronic storage medium tracking identifier is in a burst cut area (Abstract, figure 15, figure 21, col. 20 lines 32-65) and a digital code is in the burst cut area (figure 15, figure 21, col. 20 lines 32-65).

Mages et al and Takahashi are analogous art because they both store content information on an optical disk.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the Burst Cut Area of Takahashi in the CD-ROM tracking and keying system of Mages et al because Takahashi teaches increased speed for file management of mass storage devices such as an optical disc (col. 1 line 63 – col. 3 line 58).

14. Claims 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al (U.S. Pat 5,892,825) in view of Takahashi (U.S. Pat 5,878,020) as applied to claims 31 and 32 above, and further in view of Brindze et al (U.S. Pat 5,822,291).

Mages et al as modified by Takahashi teach a method for tracking the distribution of content electronically while incorporating an optical medium identifier in a Burst Cut Area as recited in claims 30 and 31 for the reasons above, differing from the invention as recited in

claims 33-36 in that their combined teaching lacks determining as a function of the tracking information a retailer that sold the electronic storage medium, performing a table lookup to determine one or more authorized titles, further comprising writing a transaction to a database memorializing processing and the URL includes an address of a website of a retailer where the electronic storage medium was purchased.

Brindze et al teaches further comprising determining as a function of the tracking information a retailer that sold the electronic storage medium (col. 11 line 53 – col. 12 line 33), performing a table lookup to determine one or more authorized titles (col. 9 lines 25-49), further comprising writing a transaction to a database memorializing processing (col. 5 lines 1-7, col. 9 line 35 – col. 10 line 20, col. 12 lines 1-18) and the URL includes an address of a website of a retailer where the electronic storage medium was purchased (col. 11 line 53 – col. 12 line 33).

Mages et al as modified by Takahashi and Brindze et al are analogous art because they both provide tracking for individual electronic storage medium.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize tracking the retailer, determining authorized titles and memorializing transactions of Brindze et al in the CD-ROM tracking and keying system of Mages et al as modified by Takahashi because Brindze et al teaches controlling the authorization and use of electronic media to stop piracy of content, improved marketing by retailers and tracking of individual copies of mass produced works (col. 1 line 10-50).

Response to Arguments

15. Applicant's arguments filed 9/17/01 have been fully considered but they are not persuasive.

Regarding the objection to the length of the abstract, that objection has been withdrawn, however objection to the content is made above.

The objection to the specification is withdrawn due to the amendment to the specification

Regarding the 35 USC § 112 rejections, claims 1-18 were cancelled and therefore the rejection of those claims is withdrawn, however the new claim presented contain deficiencies and a 35 USC § 112 rejection of those claims is above.

Regarding the 35 USC § 102 and 103 rejections, applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection for the newly added claims.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hudetz et al (U.S. Pat 5,978,773) teaches a method for using identification codes to access remote computers for articles of commerce.

17. Applicant's amendment introducing new claims necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2121

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

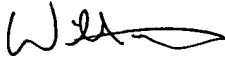
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (703) 305-7399. The examiner can normally be reached on 6:30 - 4:00 M-Th and alternate F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Grant can be reached on (703) 308-1108. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Paul L Rodriguez
Examiner
Art Unit 2121

plr
November 7, 2001


WILLIAM GRANT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100
10/8/01